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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/565,982	01/26/2006	Melchor Daumal Castellon	001058-00031	9466
27557 7590 03/15/2010 BLANK ROME LLP WATERGATE 600 NEW HAMPSHIRE AVENUE, N.W. WASHINGTON, DC 20037				
EXAMINER				
DIAZ, THOMAS C				
ART UNIT		PAPER NUMBER		
3656				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/565,982

Applicant(s)

DAUMAL CASTELLON, MELCHOR

Examiner

THOMAS DIAZ

Art Unit

3656

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05/21/2009 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/5508)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3-7, 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Runkle (USP 3444753).

Regarding claim 1, Runkle discloses a similar device comprising:

a female member (fig.1 or 2, 28) adapted for slidably receiving a male member (fig.1 or 2, 12) therein and at least one metal strip (fig.1 or 2, 22) that is separate from the male member (since the metal strip is a separate component and is not one-piece with the male member then it reads on the limitation of being separate from the male member) fitted therebetween having an uneven contact surface (fig.1 or 2, for example 46 is uneven since it is in the form of a wedge. It is noted that various interpretations can be given to the contact surface and that the entire outer surface of the strip can be the contact surface), characterized in that said metal strip is fitted between the male member and the female member and inside at least one recess (fig.1-3, 20) in a fastening cage (fig.1-3, 16; has recesses 20) clamped to the external surface of said male member (fig.1, the cage is clamped to the male member at least by the forces of

the metal strips interacting with the female member and by the action of member 34, 36).

Regarding claim 3, Runkle discloses said cage is injected directly on the male member. Regarding the product by process recitations in this claim, even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. See MPEP 2113 for more information.

Regarding claim 4, Runkle discloses a plurality of metal strips (fig.1 and 2, 22; there are multiple ones) fitted inside respective recesses (fig.1 and 2, there are multiple recesses) of said cage.

Regarding claim 5, Runkle discloses a similar device comprising a female member (fig.1 and 2, 28) adapted for slidably receiving a male member (fig.1 and 2, 12) therein; at least one metal strip (fig.1 and 2, 22) that is separate from the male member (since the metal strip is a separate component and is not one-piece with the male member then it reads on the limitation of being separate from the male member) having an uneven contact surface (fig.1 or 2, for example 46 is uneven since it is in the form of a wedge. It is noted that various interpretations can be given to the contact surface and that the entire outer surface of the strip can be the contact surface); and a fastening cage (fig.1-3, 16) fitted between the male member and the female member, said

fastening cage having at least one recess (fig.1-3, 20), said fastening cage surrounding said male member (see fig.3), and said at least one metal strip received in said at least one recess (see fig.1-3).

Regarding claim 6, Runkle discloses a plurality of metal strips (fig.1 and 2, 22; there are multiple ones) fitted inside respective recesses (fig.1 and 2, there are multiple recesses) of said cage.

Regarding claims 7 and 10, Runkle discloses said male member has a substantially polygonal cross-sectional shape (see fig.2).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Runkle (USP 3444753) in view of Dykema et al. (USP 5417614).

Regarding claim 2, Runkle fails to disclose said cage is clamped to the outside of the male member by deformations on the lateral surface (of the male member) thereof.

Dykema et al. teaches the use of a deformation on (fig.5, 70) on the lateral surface of a male member (fig.5, 38) for the purpose of clamping a cage (fig.5,

30) to the male member and in order to prevent dislodging of the cage (col.4, lines 16-18).

It would have been obvious to one having ordinary skill at the time of the invention to modify the male member disclosed by Runkle to include a deformation as taught by Dykema et al. for the purpose of providing improved clamping of the cage to the male member and in order to prevent dislodging of the cage (col.4, lines 16-18).

Claims 8, 9, 11, 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Runkle (USP 3444753) in view of Arnold (USP 5152627).

Regarding claims 8, 9, 11, and 12, Runkle fails to disclose said male member has a substantially triangular shape with blunt vertexes (i.e. blunt surfaces).

Arnold teaches the use of a male member (fig.2, 4) having a substantially triangular shape with blunt vertexes or surfaces.

It would have been obvious to one having ordinary skill at the time of the invention to change the shape of male member (and corresponding members if necessary) disclosed by Runkle to be substantially triangular shape with blunt vertexes or surfaces since these shapes are well known and have been used for the same purpose of allowing shafts to be telescopic as taught by Arnold. Furthermore, changes of shape are considered to be within the ordinary skill in the art.

Response to Arguments

Applicant's arguments filed 12/16/2009 have been fully considered but they are not persuasive.

Applicant argues that Runkle does not disclose the newly added limitations in the independent claims 1 and 5, that the metal strip "is separate from the male member". However, as seen in the figures presented in the Runkle reference, the metal strips (22) are separate from the male member (i.e. they are separate components and not fixedly attached to the male member) and thus Runkle still reads on the claim limitations as broadly and reasonably interpreted.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to THOMAS DIAZ whose telephone number is (571)270-5461. The examiner can normally be reached on Monday-Friday 8:30am to 5:00pm..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Ridley can be reached on (571)272-6917. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Thomas Diaz/
Examiner, Art Unit 3656

/Richard WL Ridley/
Supervisory Patent Examiner, Art Unit 3656